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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 772

JOHN PHIL FELBURN,
Petitioner,
vs.

THE NEW YORK CENTRAL RAILROAD COMPANY and FRUEHAUF TRAILER COMPANY,
Respondents.

BRIEF AND APPENDIX FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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THE NEW YORK CENTRAL RAILROAD COMPANY and FRUEHAUF TRAILER COMPANY,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Petitioner seeks a writ of certiorari to review that portion of the Judgment of the United States Court of Appeals for the Sixth Circuit ruling invalid all of the litigated claims of U. S. Patent No. 3,002,636.

Restatement of Question Presented for Review

Did the Court of Appeals and the District Court err in their concurrent ruling that the patented freight-handling method (which has never been used, either commercially or experimentally, by anyone including the patentee) was unpatentably obvious in view of (1) the fact that all of the steps of the patented method

were old, having been disclosed in prior patents, in which they were employed in essentially the same way for the same purpose, and (2) the fact that at least six months prior to the filing date of the first of petitioner's three successive applications for the patent in suit, a brochure published by another had illustrated and described the combination of these old steps to form the complete patented method?

Restatement of the Case

Petitioner's "Statement of the Case" varies in several significant respects from the facts as concurrently found by the District Court and the Court of Appeals.

Petitioner cites respondents' own advertising as claiming operational advantages for the patented freight-handling method. But this advertising related to respondents' accused "Flexi-Van" system, which has little in common with the method described in the patent claims. The District Court found that the patented freight handling system had never been used, either by the respondents[1] or by the petitioner himself.[1a]

The District Court also found that respondents' Flexi-Van system was developed entirely independently of petitioner;[1b] that the petitioner learned of respondents' system when it was publicly demonstrated with widespread publicity;[2] that petitioner thereafter abandoned his then-pending patent application containing claims directed to a clearly different series of

[1] Finding 24, p. A-6, *post*.
[1a] Finding 11, p. A-6, *post*.
[1b] Finding 7, p. A-5, *post*.
[2] Finding 8, p. A-5, *post*.

steps, and filed a continuation-in-part application with added drawings illustrating a modified system more similar to respondents', and with broader claims drafted for the obvious purpose of covering respondents' system, but these broader claims were rejected as unpatentable over the prior art and were cancelled by petitioner.[3]

The District Court also found that, during the subsequent prosecution of his patent application, petitioner repeatedly argued that his narrower remaining claims should be allowed over the prior patents cited by the Patent Office because these claims contained the very limitations which now prevent their applicability to respondents' accused system.[4]

The District Court further found that every step of the patented method was old, having been disclosed by prior patents in which they were employed in essentially the same way for the same purpose.[5]

All of these findings supporting the District Court's rulings of invalidity and non-infringment were either expressly affirmed or left undisturbed by the Court of Appeals.

The petition for certiorari does not mention any of the foregoing grounds of invalidity, but is based entirely upon the allegation of error in one other ground of invalidity. This concerns the Behrens brochure, which was printed in Germany and mailed to 142 leading U. S. and European firms in the transportation industry commencing in December, 1955, six months

[3] Finding 12, p. A-6, *post*.

[4] Findings 25-47, pp. A-7 to A-11, *post*.

[5] Findings 56-64, pp. A-11 to A-14, *post*.

prior to the filing of petitioner's original patent application.[6] It is not disputed that this brochure discloses a freight handling method which satisfies all of the limitations of the patent claims.

At the trial, petitioner attempted to prove that he had invented the patented method prior to the publication of the Behrens brochure, but the District Court found his proof inadequate.[7] Thus, petitioner's repeated references to Behrens as a "subsequent inventor"[8] are unsupported by the evidence and contrary to the undisturbed findings of the District Court.

The Court of Appeals did not deem it necessary to pass on this issue of alleged priority of invention, ruling that, at the very least, the Behrens brochure established the substantially contemporaneous "independent development" of another, and constituted further evidence that the combination of old steps employed in the patented method was not patentably inventive.[9]

Petitioner charges that the Court erred in treating Behrens as a person of "ordinary skill in the art,"[10] whereas he is, in fact, "a giant in the field"[11] whom petitioner equates with "an Edison or an Einstein".[11a] The record is devoid of evidence supporting any such eulogism.

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[6] Finding 65, p. A-14, *post;* Court of Appeals opinion, p. 28 of Petition.

[7] Finding 71, p. A-16, *post.*

[8] Petition, pp. 2, 4, 8.

[9] Court of Appeals Opinion, Petition, pp. 28-29.

[10] 35 U.S.C. § 103, Petition, p. 12.

[11] Petition, p. 6.

[11a] *Ibid.*

Petitioner incorrectly states[12] that the Court of Appeals based its opinion upon "speculation". To the contrary, the Court expressly stated that it need not "rely solely upon . . . speculation as to what the art taught to one of ordinary skill . . . when we have the advantage of considering what Behrens did."[13]

Reasons for Denying the Writ

The use of the Behrens brochure by the Court of Appeals was consonant with this Court's repeated ruling that substantially simultaneous and independent development by others should be taken into consideration in determining whether the invention would have been "obvious" to those of "ordinary skill in the art."

For example, in *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177, 185 (1925), this Court stated:

> "The adaptation independently made by engineers and builders of these familiar appliances to the movement and distribution of concrete cement in building operations and the independent patent applications, within a comparatively short space of time, for devices for that purpose are in themselves persuasive evidence that this use, in combination, of well known mechanical elements was the product only of ordinary mechanical or engineering skill and not of inventive genius. Atlantic Works v. Brady, 107 U. S. 192, 2 S. Ct. 225, 27 L. Ed. 438. It is but 'the suggestion of that common experience, which arose spontaneously and by a necessity of human reasoning, in the minds of

[12] Petition, p. 4.

[13] Petition, p. 27.

those who had become acquainted with the circumstances with which they had to deal.' Hollister v. Benedict Manufacturing Co., 113 U. S. 59, 72, 5 S. Ct. 717, 724 (28 L. Ed. 901)."

Thus, the question presented by the petition has already been settled, we submit properly, by this Court. No public interest whatever would be served by further appellate review in this case.

Moreover, the Behrens reference was not the only ground upon which the patent was ruled invalid; the patent was also ruled not to have been infringed by the respondents. A reversal by this Court would not therefore mean ultimate victory for petitioner. Thus the question presented is not likely to be of any consequence even to the litigants at bar.

Conclusion

The petition should be denied.

Respectfully submitted,

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APPENDIX

Findings and Conclusions of the District Court

IN THE

United States District Court

NORTHERN DISTRICT OF OHIO

EASTERN DIVISION

JOHN PHIL FELBURN,
Plaintiff,

vs.

THE NEW YORK CENTRAL R. R. CO.,
FRUEHAUF TRAILER COMPANY,
Defendants.

CIVIL ACTION
No. 36,021

FINDINGS OF FACT AND CONCLUSIONS OF LAW

Findings of Fact

Nature of the Case

1. This is an action for infringement of two U. S. patents, Nos. 2,693,889 and 3,002,636, which were issued to and are owned by plaintiff, and which relate to freight handling equipment and methods. The Complaint charges infringement of both of the two patents in suit by the "Flexi-Van" freight handling system, in both its original and its modified "Mark III" versions, as used by defendant New York Central Railroad, employing equipment manufactured by defendant Fruehauf Trailer Company.

2. The Answer denies infringement of both patents, and alleges that both patents are invalid because the alleged inventions respectively covered thereby were not new and did not involve patentable invention.

The Patents in Suit

* * * * *

4. The Felburn patent No. 3,002,636 relates to a method of transferring the trailer bed of a semi-trailer and tractor assembly having a detachable wheel assembly or bogie to a railway "flat car" by the successive steps of: backing the trailer bed by means of the tractor in a direction generally perpendicular to the longitudinal axis of the flat car to a position wherein the rear end of the bogie engages the side of the flat car; removing the locking pins in the tow bars to permit telescoping of the tow bars; backing the tractor to push the trailer smoothly over the bogie and onto the floor of the flat car to the point where a V-shaped slot at the bottom of the trailer is engaged with a kingpin projecting upwardly from the flat car to form a pivot for rotation of the trailer on the flat car; attaching a separate towing and lifting vehicle to the front of the trailer to relieve the weight of the trailer from the tractor and bogie and support the trailer solely upon the flat car and the towing vehicle; and swinging the trailer by the towing vehicle to a position wherein the trailer is aligned with the flat car.

Of the fifteen claims of the '636 patent, three (Claims 11, 14 and 15) are charged to be infringed by the original Flexi-Van system, and seven (Claims 1, 3,

4, 11, 12, 14 and 15) are asserted against the Mark III system.

The Accused Flexi-Van Systems

5. The original Flexi-Van system employs a specially built railroad car having a rotable turntable which is raised and lowered by means of a hydraulic jack. The frame of the railroad car consists of a single, relatively narrow girder, the ends of which rest upon the wheel trucks of the car and the central portion of which is recessed to receive the turntable. The bogie is slidable on rails extending lengthwise of the undersurface of rear portion only of the trailer. The turntable is provided at its upper surface with a pair of skids which are also adapted for sliding engagement with the rails on the trailer.

To load the trailer onto the railroad car, the turntable is rotated to orient the skids transversely of the car. The trailer is then backed by the tractor transversely of the railroad car to a point opposite the ends of the skids on the turntable. Then the bogie is unlocked from the trailer and the tractor is backed to push the trailer smoothly from the bogie onto the skids of the turntable to a position wherein the trailer is centered lengthwise on the turntable. Thereupon the tractor is disconnected from the trailer, and the turntable is raised by the hydraulic jack to lift the trailer off of the bogie. The turntable is then rotated by hand to align the trailer with the railroad car, whereupon the hydraulic jack is again actuated to lower the trailer to a point where its two ends are supported on the railroad car and the depending kingpin at the front end of the

trailer is lowered into a recess on the railroad car to lock the trailer against rotation.

After the trailer has been lifted off the bogie and rotated parallel to the railroad car, the bogie may then be connected to the tractor and hauled away for other use. This is accomplished by a removable towbar which is temporarily attached to the bogie during the towing operation, and which is provided at its forwardly projecting end with a cam surface which is engaged by the tractor as the tractor is backed up toward the bogie, thereby raising the front wheels of the bogie off the ground to permit turning of the bogie without scrubbing of the tires.

6. In the Flexi-Van Mark III system, the railroad car is generally similar to that used in the original Flexi-Van, except that no hydraulic jack is provided for raising and lowering the turntable. Instead, the outer ends of the skids on the turntable are provided with inclined surfaces which engage the rear end of the trailer as it is backed onto the turntable by a special "Commando" tractor to cam the trailer up off of the bogie. The trailer is not backed to a balanced position on the turntable, as in the original Flexi-Van, but only to the point where its rear end is supported on the turntable. During this operation, the fifth wheel of the tractor is raised by a built-in hydraulic jack to lift the front end of the trailer up to the same height as its rear end. A transversely extending nose wheel mounted for vertical movement at the front end of the tractor is then lowered into contact with the ground, raising the regular front wheels of the tractor off the ground. This nose wheel

is rotated to swing the front end of the tractor in a circular arc around to a position where the tractor is perpendicular to the front end of the trailer. Then the nose wheel is raised out of engagement with the ground, lowering the front wheels of the tractor again to the ground, and the tractor is backed to swing the front end of the trailer around to a position adjacent the railroad car. At that point, a special hydraulic ram on the tractor pushes the front end of the trailer the remaining short distance to the point where the trailer is parallel to the railroad car.

After the trailer is thus removed from the bogie, the bogie is carried away on hinged arms at the rear end of the "Commando" tractor, these arms being extended and inserted beneath the bogie and raised to lift the bogie completely off the ground.

7. The two Flexi-Van systems were conceived and developed by Leo L. Mellam, President of New York Central Transport Company, in conjunction with engineers of the Strick Division of Fruehauf Trailer Company. Their work was done entirely independently of Felburn, and they obtained a number of patents of their own covering the basic system and the components thereof.

8. In early 1947, a set of experimental equipment for the original Flexi-Van system was constructed. This equipment was publicly demonstrated in New York during the first week in May 1957, with resulting widespread publicity. Some of the publications describing the Flexi-Van system came to the attention of Felburn himself.

9. In April, 1958, the Flexi-Van equipment went into regular commercial service on the New York Central.

10. During the latter part of 1960, after several years of use of the original Flexi-Van equipment, the Mark III equipment was designed and developed, to achieve several operating advantages over the original equipment. The Mark III equipment went into use in mid-1961; when the manufacture of this new equipment was commenced, production of the original Flexi-Van equipment was substantially terminated.

11. Felburn, although the head of both a truck-trailer equipment manufacturer and a trucking company, admittedly never used either of his two systems commercially. He did contact a large number of railroads and equipment manufacturers in an attempt to interest them in his various freight handling ideas, but without any success.

12. After he learned of the original Flexi-Van system, Felburn added a new sheet of drawings to one of his three applications for the '636 patent, showing a method more similar to the Flexi-Van system than that which he had previously disclosed, and he also added a number of broader claims which were obviously intended to cover Flexi-Van, but all these claims were rejected and ultimately cancelled.

Infringement

* * * * *

24. The claims of the Felburn '636 Patent in suit are not applicable to the methods performed in either of the two Flexi-Van systems.

25. Neither Flexi-Van system employs a "Flat-Car" as called for in all of the claims of the '636 Patent.

26. An interpretation of the expression "flat-car" sufficiently broad to cover the specially designed railroad cars employed in the two Flexi-Van systems would be inconsistent with the limited definition which Felburn applied to the expression during the prosecution of his applications for the '636 patent, in order to persuade the Patent Office to grant the patent.

27. After all of the claims of his first application for the '636 patent had been rejected by the Patent Office, Felburn amended the specification to define the expression "Flat car" as used in his claims, as a "railway car wherein the platform lies in a common plane throughout the load carrying area . . .".

28. As limited by this definition, the term "flat car" would not apply to the special railroad cars used in either of the two Flexi-Van systems, since neither rail car has an upper surface which "lies in a common plane".

29. During prosecution of his three applications for the '636 patent in suit, Felburn repeatedly told the Patent Office that his invention involved the use of "conventional flat bottom flat cars" and therefore differed from prior systems involving expensive, specially constructed flat cars having special attachments which reduced their utility for other purposes.

30. Felburn also repeatedly told the Patent Office that adding a turntable to a conventional railroad flat

car was contrary to his concept, since such a modification would add to the height and cost of the car, even to the point of rendering the cost "prohibitive." He even stated expressly that a railway car which is provided with a turntable is not the "equivalent" of the "flat car" called for in his claims.

31. Felburn also told the Patent Office that a car which had a compensating recess to lower the height of the trailer on the car is not a "flat car" within the meaning of his claims.

32. Felburn further repeatedly and emphatically told the Patent Office that according to his invention the trailer bed is rotated while in "direct contact" with the floor of the flat car.

33. As thus limited to the loading of trailers onto conventional flat bottom flat cars without a turntable or other special equipment, the claims of the '636 patent do not apply to the specially built rail cars of the Flexi-Van systems, which have turntables, which have no load supporting floors, and are neither adapted for nor used for handling conventional loads.

34. In neither Flexi-Van system are swivel means under the trailer body registered with swivel means on the rail car to form a pivot, as called for in Claims 1, 3, 4, 14 and 15 of the '636 patent.

35. During prosecution of his applications for the '636 patent, Felburn argued that this language in his claims requires that a pivot-forming part be provided

on the bed of the trailer to cooperate with a complementary pivot-forming part on the flat car.

36. In neither Flexi-Van system is there any swivel means on the trailer body which is registered with swivel means on the rail car to form a pivot. Instead, the rail cars of both Flexi-Van systems are provided with rotatable turntables which are permanently mounted on the cars. In each system, the pivotal mounting for turntable exists before the trailer is placed on the car and is not formed by registering anything on the trailer with anything on the rail car.

37. Plaintiff's attempt to apply to the Flexi-Van systems the language of his claims which calls for registering swivel means to form a pivot is therefore inconsistent with his argument to the Patent Office that it "necessitates that a pivot forming part be provided on the bed of the trailer".

38. Neither Flexi-Van system involves the use of a towing vehicle in the manner described in Claims 1, 3, 4 and 12 of the '636 patent.

39. In the Mark III system, the swinging of the trailer body on the railroad car is accomplished by the same tractor which pushes the trailer body onto the flat car, rather than by a "towing vehicle" which relieves the weight of the trailer from the tractor, as called for in Claims 1, 3, 4 and 12.

40. In the Mark III system there is no towing vehicle which is "offset from the tractor", as more specifically recited in Claims 3 and 4.

41. In the Mark III system, there is no towing vehicle which performs the step of "lifting" the front end of the trailer to relieve its weight from the tractor as further recited in Claim 12.

42. In neither Flexi-Van system is the trailer bed backed to a position wherein the rear end of the bogie "adjoins" the side of the flat car, as called for in Claims 11, 12, 14 and 15 of the '636 patent.

43. This is another critical limitation in the claims because no such limitation appeared in any of the claims as originally filed, but it was added to the claims during prosecution in an attempt to obtain their allowance. After adding this limitation, Felburn argued to the Patent Office that the abutment of the bogie against the flat car constituted a significant distinction between his claimed invention and the prior art cited by the Patent Office.

44. In both the original Flexi-Van and the Mark III systems, by contrast, the backing of the trailer is stopped while the rear end of the bogie is still spaced from the ends of the skids on the turntable and the brakes on the bogie are locked before the backing of the tractor is resumed to shove the trailer body onto the turntable.

45. In the Mark III system, the trailer is not pushed "smoothly" over the bogie, and onto the railroad car "without considerable separation" between the trailer and bogie, as called for in Claims 11, 12, 14 and 15.

46. This is also a critical limitation in the claims because it was not present in any of the claims of the original application for the '636 patent as filed, but was added by amendment during prosecution of the applications in order to distinguish the claims from the prior art cited by the Patent Office.

47. In the Mark III system, by contrast, the trailer is cammed up off of the bogie by engagement of its lower rear corner with sloping surfaces at the outer ends of the skids of the turntable during backing movement by the tractor.

Validity

* * * * *

The Felburn '636 Patent

56. All of the steps recited in Claims 1, 3, 4, 11, 12, 14 and 15 of the '636 patent were old, having been disclosed in prior patents and publications, in which they were employed in essentially the same way and for the same purpose. No new or unexpected result was achieved by Felburn's combination of these old steps into the methods claimed, and no ingenuity beyond that of an ordinary mechanic was involved in making such combination.

57. The Winn U. S. patent No. 1,541,457, issued in 1925, was not cited by the Patent Office against any of the applications for the '636 patent. It discloses a semi-trailer and tractor assembly in which the front end of the trailer bed is detachably connected to the tractor through the semi-trailer frame with a multiple axle

wheel unit supporting the rear portion of the trailer bed. Winn further discloses the loading of the cargo bodies onto a railroad car having turntables rotatably mounted thereon by the successive steps of: rotating the turntables to a position transverse of the railroad car, backing the trailer by means of the tractor until it is adjacent the side of the railroad car, unlocking the cargo bodies from the wheel unit, pushing the cargo bodies smoothly over the wheel unit and onto the railroad car, and rotating the turntables and cargo bodies to a position parallel to the railroad car.

58. Winn discloses everything called for in Claim 11 of the '636 patent except (1) the use of a conventional "flat car," (2) the backing of the cargo bodies into actual contact with the railroad car, and (3) the use of the tractor for pushing the cargo bodies onto the rail car.

59. None of these missing features was novel at the time of Felburn's alleged invention. The prior Zubatsky U. S. patent No. 2,369,384, issued in 1945, discloses the use of a tractor to push a trailer from its removable bogie onto a conventional flat car. Claim 11 is thus fully anticipated by the combination of Winn and Zubatsky.

60. The McGregor U. S. patent No. 2,543,295, issued in 1951, discloses the backing of the trailer of a semi-trailer and tractor assembly by the tractor in a direction generally normal to the axis of a rail car until the rear end of the trailer adjoins and is generally level with the rail car and the wheel unit adjoins the side of

the rail car. Then the wheel unit is unlocked from the trailer, and the trailer is slid onto the rail car by movement of the tractor, the wheel unit being simultaneously pulled from beneath the trailer. The trailer is then rotated on the turntable to a position parallel to the railroad car.

61. McGregor discloses all of the steps recited in Claim 11 of the '636 patent in suit except (1) the use of a conventional "flat car" without a turntable, as defined by Felburn, and (2) the movement of the trailer onto the flat car by *backing* movement of the tractor while the wheel unit is stationary.

62. Both of these two features, lacking in McGregor, are disclosed by the prior Zubatsky patent. Thus, the entire combination of Claim 11 is also anticipated by the combination of McGregor and Zubatsky.

63. The additional step of registration of swivel means on a trailer with swivel means on a railroad car to form a pivot for rotation of the trailer to a position parallel to the car, as recited in Claims 1, 3, 4, 14 and 15 of the '636 patent, was not new, but is disclosed in the prior Ross U. S. patent No. 1,734,303 issued in 1929, and in the prior Francis U. S. patent No. 1,968,196 issued in 1934.

64. The additional steps of attaching a towing vehicle to one side of the front end of the trailer bed and using the towing vehicle to swing the trailer bed to a position parallel to the flat car, as recited in Claims 1, 3, 4 and 12 of the '636 patent, were not new, but are

disclosed by a number of prior patents including the aforementioned Francis patent, the Nelson U. S. patent No. 2,782,054 issued in 1957 on an application filed in 1953, and the Gutridge U. S. patent No. 2,819,687 issued in 1958 on an application filed in 1953.

65. Rudolf Behrens, the proprietor of a German trucking firm, published a brochure disclosing a freight handling system which is virtually identical to that described in the broadest claims of the '636 patent. The first edition of this brochure was printed in June 1955 and was mailed out during the latter part of 1955. The second edition, was sent out shortly thereafter, with all the mailing being completed within four months after December 1955, before the filing date of Felburn's first application for the '636 patent. One or the other of these two versions of the publication was sent to one hundred firms in Europe and to forty-two firms in the U. S. A., including the leading manufacturers of trucks and trailers, railroads and trucking companies.

66. This Behrens publication was not cited by the Patent Office against any of the applications for the '636 patent.

67. The Behrens publication illustrates a semi-trailer and tractor assembly in which the bogie is slidable along the bottom of the trailer and removable therefrom for loading of the trailer onto a conventional railroad flat car. The trailer is backed up by the tractor transversely of the flat car to a position wherein the rear end of the trailer adjoins and is generally level

with the upper surface of the flat car. At this point, the trailer is unlocked from the bogie to permit sliding of the bogie along the undersurface of the trailer. Then the backing of the tractor is resumed to push the rear end of the trailer onto the turntable. The rear end of the bogie engages the side of the flat car to prevent movement of the bogie as the trailer is slid onto the flat car. In one embodiment, shown in Figure 2 of the drawings of the publication, the trailer is pushed to a position wherein it is centered over the flat car. Thereupon, the front end of the bogie is connected to the rear end of the tractor by means of a hitch and the bogie is pulled by the tractor from beneath the trailer. Then the trailer is rotated to a position parallel to the freight car.

68. Every step recited in Claim 11 of the '636 patent in suit is fully anticipated by the system disclosed by Behrens.

69. The system disclosed by Behrens is fully operative. There are no defects in it except for omissions of routine construction detail which could be supplied by any mechanic. These details are the type which are frequently omitted from patent drawings, which may be merely a schematic indication of a principle of operation.

70. The Behrens publication constituted a printed publication disclosing the method covered by Claim 11 of the '636 patent which was published and distributed at least six months before the filing date of the first application for the '636 patent.

71. Felburn has not established either a reduction to practice of the invention of the '636 patent or any diligence toward such reduction to practice, prior to the filing date of his first application for such patent.

Conclusions of Law

1. This Court has jurisdiction of the subject matter and of the parties.

2. The patents in suit, being only "paper patents" which were never used commercially, should be strictly construed.

* * * * *

5. Plaintiff is estopped by his amendments and arguments before the Patent Office to contend that Claims 1, 3, 4, 11, 12, 14 and 15 of the Felburn U. S. patent No. 3,002,636 are applicable to the freight handling methods performed by defendants or with their equipment.

6. Said patent No. 3,002,636 has not been infringed by either of the defendants.

7. The failure of the Patent Office to cite the most relevant prior art against the applications for the patents in suit destroys the rebuttable presumption of validity which usually attaches to a granted patent.

* * * * *

9. Said patent No. 3,002,636 is invalid and void for lack of novelty and patentable invention.

PETITIONER'S REPLY BRIEF

Office-Supreme Court, U.S.
FILED
JAN 13 1966
JOHN F. DAVIS, CLERK

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vs.

THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

Respondents.

PETITIONER'S REPLY BRIEF.

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TABLE OF AUTHORITIES.

Cases.

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Cuno Engineering Corp. vs. Automatic Devices Corp., 314 U. S. 84; 62 S. Ct. 37 ---------- 4

Elliott vs. Youngstown, 181 Fed. 345 ---------- 5

Great Atlantic and Pacific Tea Co. vs. Supermarket Eq. Corp., 340 U. S. 147; 71 S. Ct. 127 ---------- 4

Statutes.

35 U. S. C. Sec. 103 ---------- 6

In the Supreme Court of the United States

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JOHN PHIL FELBURN,

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THE NEW YORK CENTRAL RAILROAD COMPANY, and FRUEHAUF TRAILER COMPANY,

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PETITIONER'S REPLY BRIEF.

The Petition for Certiorari in effect asks the question, "who is the man of ordinary skill" to whom the bench and bar must look to determine the question of obviousness.[1] In answering this question, the Appellate Court looked to another inventor in determining who is the man of "ordinary skill." Such erroneous test was the basis for the Appellate Court's decision, and for the Petition. Respondents evade the issue and direct their attention instead to what the District Court found,[2] as though certiorari were being taken from the District Court's opinion, rather than from that of the Appeals Court.

Respondents' approach is not only improper in form and procedure, but it also disregards the Appeals Court reversal of the District Court's finding that the steps were not anticipated by the references and therefore were novel,

[1] Petition, page 2.

[2] Respondents' Opposition Brief, pages 2-4.

thereby leaving obviousness as the sole question.[3] Moreover, the Appeals Court did not "concurrently rule" as claimed by Respondents at pages 1-2 of their Opposition Brief. Such an assertion by Respondents is an erroneous statement of the Appellate Court Opinion. Respondents are attempting to substitute the ruling of the District Court for the ruling of the Appeals Court.

The decision on obviousness was based on the sole basis of "speculation" or by holding that because Behrens also discovered a portion of the invention, *a priori* it is not invention. We know that "speculation" is an improper test. This leaves us only with the proposition that because Behrens assertedly subsequently invented the concept, it is not invention—even though Behrens was himself an inventor and the holder of a later German patent on allegedly the same concept and where his brochure indicates the revolutionary character of his discovery.[4] Such an approach is question begging of the first degree.

Respondents' evasion of the central issue highlights Petitioner's case. When Respondents finally do turn to the Appeals Court decision, their quotation of the opinion supports Petitioner's position. Respondents repeat as their position the very same position which was taken by Petitioner. As stated at page 5 of the Respondents' Opposition Brief:

> "To the contrary, the Court expressly stated that it need not 'rely solely upon * * * speculation as to what the art taught to one of ordinary skill * * * when we have the advantage of considering what Behrens did.' "

This is exactly what Petitioner has been contending—that the Appeals Court based its decision either upon

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[3] Petition, Appendix, pages 20-21.

[4] Petition, pages 5-6.

speculation or upon what Behrens did.[5] Since Behrens was himself an inventor and held a late German patent on the same alleged invention, the Appeals Court based its decision upon the erroneous premise of looking to what is obvious to an inventor rather than to one of "ordinary skill." Moreover, there is no showing that the idea was even obvious to the inventor, Behrens. On the contrary, the German Patent Office and Behrens certainly did not think the idea obvious, as Behrens applied for and received a patent on his idea. Respondents have not denied that the patent and brochure indicate that the changes swept away the long existing difficulties of the prior art.[6]

The present case provides an excellent test case for determining the question of who is one of "ordinary skill" in the art. Respondents could find no other basis for the Appellate Court's decision. We have an Appeals Court that admitted that it must either speculate or look to Behrens. Thus, we have a case which sharply focuses upon the question of who is one of "ordinary skill" in the art—the question still undecided by this Court.

Respondents state that Behrens was neither an Einstein nor an Edison.[7] What is important is that he was clearly a person of more than ordinary skill. The Patent Act does not say "obvious to anyone other than a genius." It says, obvious to one of "ordinary skill." Behrens was certainly not a man of "ordinary skill." Significantly Respondents have never maintained, or been able to show from the record, that he was a man of ordinary skill.

Contrary to Respondents' assertion,[8] the reversal of this decision certainly would be of consequence to the liti-

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[5] Petition, page 4.

[6] Petition, pages 5-6.

[7] Respondents' Opposition Brief at page 4.

[8] Respondents' Opposition Brief at page 6.

gants. It will entitle the litigants to a decision by the Appeals Court based upon the proper law—a consideration important to the litigants, and to our judicial system. When the law is properly applied, it will be seen that Petitioner was, in fact, entitled to a valid patent and that Respondents have infringed that patent (the latter being an issue which the Appeals Court avoided). Respondents' assertion at page 6 of their Opposition Brief is erroneous in stating that "the patent was also ruled not to have been infringed." The Appeals Court stated "it is not necessary to pass upon the issues of infringement tried below." [9] Respondents' erroneous statement of this fact further shows that Respondents are unable to meet the question proposed, on its merits.

The ruling will also be of consequence to the bench and bar as it will define the still unanswered question of who is the man of "ordinary skill."

The *Concrete Appliances* case cited by Respondents [10] does not resolve the question. The case was decided long prior to the 1952 Act, and has been repeatedly cited as authority for the "flash of genius" test which was repudiated by the 1952 Act. Mr. Justice Douglas, in his dissent in the *Great Atlantic and Pacific Tea Co. vs. Supermarket Eq. Corp.*,[11] quotes the "inventive genius" test of Mr. Justice Stone in the aforesaid *Concrete Appliances* case. In *Cuno Engineering Corp. vs. Automatic Devices Corp.*[12] immediately after the citation of a purality of cases, including the aforesaid *Concrete Appliances* case, *cited supra*, the Court interpreted the cases by saying:

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[9] Petition, Appendix, page 31.

[10] 269 U. S. 177, 185, cited in Respondents' Opposition Brief at page 5.

[11] 340 U. S. 147, 154; 71 S. Ct. 127, 131, n. 1.

[12] 314 U. S. 84, 91; 62 S. Ct. 37, 40, 41.

> "That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling."

Moreover, even if it were proper, despite the subsequent enactment of the 1952 Act, the holding stands for the proposition that where the need is *short* (in that case it was three years) the fact that *several* other workers developed the same idea is evidence that there is not "inventive genius," where there was a progressive development. The Appellate Court decision in the *Concrete Appliances* case[13] recognized the distinction in quoting as follows from *Elliott vs. Youngstown*:[14]

> "The fact that so many persons caught the idea goes rather to prove that it was simple and obvious, and not that it required inventive genius to conceive. *It is not* like the case where the art is waiting for the device, and inventors striving unsuccessfully to produce it, under which circumstances invention may well be held to appear." (Emphasis added.)

The Supreme Court in ruling on *Concrete Appliances Co. vs. Gomery*[15] made special note of the fact that the need for a device for handling "wet" cement was not a long-felt want. This Court noted that the need did not arise until 1905, and that the assemblage of elements of the patent was made by *several* others by 1908, only *three* years later, with the intervening short period evidencing rapid development by others of portions of the ideas.

Lastly, and most important, the ruling of this Court in the *Concrete Appliances Co.* case does not answer the question propounded for review—who is the man of "ordinary skill" to whom the Patent Act refers? The Appeals Court

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[13] 291 F. 486, 491.

[14] 181 Fed. 345, 349.

[15] 269 U. S. 177, 182, 46 S. Ct. 42, 44.

in the present case held that it was Behrens, another inventor. By so doing, the "flash of genius" test was reinstated by looking to another inventor as the sole test of what is obvious to one skilled in the art. The Court of Appeals did so despite the fact that the seven systems relied upon by the Court as anticipation each failed to solve the problem, and evidenced many attempts to solve it since at least 1925.[16]

The Drafters of the Patent Act wanted to stimulate the development of ideas which were not obvious to one of ordinary skill.[17] The Drafters did not intend the test to be what is obvious to someone of *extraordinary* skill. Yet the ruling of the Appellate Court herein, by letting the fact that Behrens, himself an inventor, and holder of a German patent on the idea, be the sole basis for its opinion, has reinstated the "Inventive Genius" test which the 1952 Act replaced. It did so by erring in dealing with the other side of the coin—namely to define who is the man of "ordinary skill" to whom the statute refers. It is this question which Petitioner respectfully asks this Court to settle.

Respectfully submitted,

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[16] Petition, page 8.

[17] 35 U. S. C. Sec. 103, Printed in Petition, Appendix, at page 12.